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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,868	07/23/2001	Theodore W. Watler	018684001310	4209

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EXAMINER	
LY, NGHI H	

ART UNIT	PAPER NUMBER
2686	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/911,868	WATLER ET AL.	
	Examiner	Art Unit	
	Nghi H. Ly	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-20,24-42,46-63 and 87-105* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-20, 24-42, 46-63 and 87-105* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *06/21/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2-7, 9-20, 24-29, 31- 42, 46-51, 53-63, 87-92 and 94-105 are rejected under 35 U.S.C. 102(b) as being anticipated by Sainton et al (US 5,854,985).

Regarding claims 2, 24, 46 and 87, Sainton teaches a system for determining a charge (see Abstract) in connection within a data communication session (also see Abstract), comprising: a wireless device capable of communicating with a network (see Abstract and column 2, lines 6-25), and a data rating application residing in the wireless device (see fig.2, box 1 and column 10, lines 42-65), wherein the data rating application is configured to determine the charge in connection with the data communication session by selecting one or more rates (see column 2, lines 40-52, column 2, line 64 to column 3, line 3 and column 16, lines 27-55) and one or more units of measure applicable to the data communication session as determined by the type of data, the usage of data, the source of the data, the service level selected, the service level achieved and/or the connection method (see column 5, line 52 to column 6, line 14. In addition, see column 2, lines 40-52, column 2, line 64 to column 3, line 3 and column 16, lines 27-55), wherein the units measure include the quality of bytes, quality of data

packets and/or the connection involved in the communication (see column 17, lines 10-20).

Regarding claims 3, 25, 47 and 88, Sainton further teaches the wireless device is a mobile phone (see fig.4A and fig.4B).

Regarding claims 4, 26, 48 and 89, Sainton further teaches the charge is based upon the quantity of bytes or data packets communicated (see column 17, lines 1-20).

Regarding claims 5, 27, 49 and 90, Sainton further teaches the charge includes flat rate for each connection (see column 17, lines 20-57).

Regarding claims 6, 28, 50 and 91, Sainton further teaches the data rating application is configured to update an account relating to the wireless device (see column 18, lines 19-30).

Regarding claims 7, 29, 51 and 92, Sainton further teaches the account resides in the wireless device (see column 18, lines 19-30).

Regarding claims 9, 31, 53 and 94, Sainton further teaches the data rating application is configured to detect one of a plurality of events which takes place during the course of setting up the data communication session, wherein the event is indicative of the type of data, the usage of the data, the source of the data, the service level selected and/or the connection method wherein the origin of the event is either the network or the wireless device (see column 8, lines 28-41 and column 16, lines 28-54).

Regarding claims 10, 32, 54 and 95, Sainton further teaches the accounting application resides in the wireless device (see column 18, lines 19-30).

Regarding claims 11, 33, 55 and 96, Sainton further teaches the data rating application is configured to end determining the charge in connection with the data communication session (see column 2, lines 40-52 and column 14, lines 35-39) after detecting an end event which takes place during the course of the data communication session, and wherein the end event is originated by either the network or the wireless device to indicate that the data communication session has ended (see column 19, lines 24-25, column 20, lines 2-3 and column 20, lines 56-59).

Regarding claims 12, 34 and 97, Sainton further teaches the data rating application resides on a smart card which is attachable to the wireless device (see column 15, lines 7-31 and column 20, lines 39-47).

Regarding claims 13, 35, 56 and 98, Sainton further teaches the wireless device includes a plurality of additional applications residing therein (see column 3, lines 44-62), and wherein the data rating application is configured to select the applicable rates and units of measure based on which one of the plurality of additional applications residing in the wireless device (see column 3, lines 44-62) will be using data received by the wireless device during the data communication session (see column 17, lines 47-57).

Regarding claims 14, 36, 57 and 99, Sainton further teaches the charge is based on usage of data received during the data communication session (see column 17, lines 1-20).

Regarding claims 15, 37, 58 and 100, Sainton further teaches the data received during the data communication session is a downloaded application, and wherein the

charge is determined based on occurrence or duration of usage of the downloaded application (see column 19, lines 59-64).

Regarding claims 16, 38, 59 and 101, Sainton further teaches the charge is based on source of data received by the wireless device during the data communication session (see column 17, lines 21-57).

Regarding claims 17, 39, 60 and 102, Sainton further teaches the charge is based on service level selected for the data communication session (see column 2, lines 40-52 and column 14, lines 35-39).

Regarding claims 18, 40, 61 and 103, Sainton further teaches the service level selected relates to speed and/or accuracy of data transmission during the data communication session (see Abstract, column 2, lines 40-52, column 2, line 64 to column 3, line 3).

Regarding claims 19, 41, 62 and 104, Sainton further teaches the charge is based on service level achieved during the data communication session (see column 2, lines 40-52 and column 14, lines 35-39).

Regarding claims 20, 42, 63 and 105, Sainton further teaches the charge is based upon the connection method (see column 17, lines 21-57).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

> subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 8, 30, 52 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton et al (US 5,854,985) in view of the Applicant's admitted prior art.

Regarding claims 8, 30, 52 and 93, Sainton teaches claim 6. Sainton does not specifically disclose the account resides at a location external to the wireless device.

The Applicant's admitted prior art teaches the account resides at a location external to the wireless device (see Applicant's background of the invention, pages 1-2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of the Applicant's admitted prior art

into the system of Sainton in order to reduce the burden on the wireless communication device.

Response to Arguments

6. Applicant's arguments with respect to claims 2-20, 24-42, 46-63 and 87-105 have been considered but are moot in view of the new ground(s) of rejection.

Regarding claims 8, 30, 52 and 93, Applicant argues that that there is no suggestion to combine the references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to do so found in the knowledge generally available to one of ordinary skill in the art in order to reduce the burden on the wireless communication device. In addition, Applicant's attention is directed to the rejection of claims 8, 30, 52 and 93 above.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

87/11/05

Marsha D Banks-Harold

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